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10/821,144	04/07/2004	H. Thomas Graef	D-1238 R2	8941

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EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT

PAPER NUMBER

3651

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,144	<b>Applicant(s)</b> GRAEF ET AL.	
	<b>Examiner</b> Leslie A. Nicholson III	<b>Art Unit</b> 3651	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/1/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/7/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is a first action on the merits of application 10/821144.

### ***Election/Restrictions***

2. The restriction filed 8/18/2005 is hereby withdrawn. All original claims filed 4/7/2004 will be examined.

### ***Specification***

3. The use of the trademark "DuPont Kapton" has been noted in this application (P57/L8-9). It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not appear to have recited this limitation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2,4,6, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, by the wording of the claim it appears as though the first note moves in the second direction, however that limitation has not been positively recited. It is unclear what direction the first note moves.

Regarding claim 4, the claim describes the first note moving in the second direction, however this limitation has not been positively recited.

Claim 6 recites the limitation "the at least one moving member" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 24, it is unclear how the stripping member can engage both the first note and at least one other note. The examiner will interpret the claim to mean the stripping member engages the first note via the other note.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 5, and 6, as best understood by the examiner (see ¶7), are rejected under 35 U.S.C. 102(b) as being anticipated by Graef USP 4,494,747.

Regarding claim 1, Graef discloses a similar method comprising:

- a) moving a first note bounding a stack of notes (11A), in a first direction from the stack in engagement with at least one picking member (28) (C10/L60-65)
- b) engaging the first note and notes other than the first note with at least one stripper member (44,47), wherein generally notes other than the first note are prevented from moving from the stack
- c) sensing with at least one sensor (48) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (44,47) (C9/L13-17)
- d) responsive to (c), moving the at least one additional note in a second direction opposed of the first direction relative to the first note (C11/L8-18)

Regarding claim 5, Graef discloses a similar method wherein (a) includes urging the first note to move in the first direction by moving at least one moving member that is in supporting connection with the stack (C7/L46-62)

Regarding claim 6, Graef discloses a similar method wherein (d) includes urging the first note to move in the second direction through moving the at least one moving member in the second direction (C4/L59-62)

10. Claims 1-4, as best understood by the examiner (see ¶¶5,7), are rejected under 35 U.S.C. 102(b) as being anticipated by Swartzendruber USP 4,159,782.

Regarding claim 1, Swartzendruber discloses a similar method comprising:

- a) moving a first note bounding a stack of notes (C), in a first direction from the stack in engagement with at least one picking member (fig.1)
- b) engaging the first note and notes other than the first note with at least one stripper member (44,46), wherein generally notes other than the first note are prevented from moving from the stack (C1/L57-65)
- c) sensing with at least one sensor (84) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (fig.1) (C4/L4-7)
- d) responsive to (c), moving the at least one additional note in a second direction opposed of the first direction relative to the first note (C4/L12-25)

Regarding claim 2, Swartzendruber discloses a similar method wherein (d) includes moving the at least one additional note in the second direction more rapidly than the first note (C4/L12-25).

Regarding claim 3, Swartzendruber discloses a similar method wherein (d) includes moving the at least one additional note in the second direction while the first note is held stationary (C4/L12-25).

Regarding claim 4, Swartzendruber discloses a similar method wherein (d) includes moving the at least one additional note in the second direction for a longer period of time than the first note is moved in the second direction (C4/L12-25).

11. Claim 1,7-10,14-21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Beskitt USP 6,302,393.

Regarding claim 1, Beskitt discloses a similar method comprising:

- a) moving a first note bounding a stack of notes (234), in a first direction from the stack in engagement with at least one picking member (190) (fig.14,27)
- b) engaging the first note and notes other than the first note with at least one stripper member (258), wherein generally notes other than the first note are prevented from moving from the stack (C13/L20-48,64-67; C14/L1-40)
- c) sensing with at least one sensor (207) before the first note has disengaged from the stack, that at least one additional note has moved with the first note from the stack past the at least one stripper member (fig.14) (C13/L64-67)
- d) responsive to (c), moving the at least one additional note in a second direction opposed of the first direction relative to the first note (C4/L12-25)

Regarding claim 7, Beskitt discloses a similar method further comprising (e) determining if each first note moved from the stack has at least one characteristic

associated with a valid note through operation of at least one validator device (38) (C6/L21-31) (fig.1).

Regarding claim 8, Beskitt discloses a similar method further comprising (f) moving notes determined to have the at least one characteristic of validity in (e), toward at least one first storage location (68) (C6/L32-59) (fig.1).

Regarding claim 9, Beskitt discloses a similar method further comprising (g) moving sheets determined as not having the at least one characteristic of validity in (e), toward at least one second storage location (70) (C6/L59-67) (fig.1).

Regarding claim 10, Beskitt discloses a similar method wherein in (g) the at least one second storage location is included in a module (10) with the at least one validator (fig.1).

Regarding claim 14, Beskitt discloses a similar method wherein (b) includes engaging notes other than the first note with at least one contact stripper member (194) and at least one non-contact stripper member (194') (C15/L65-67, fig.14,15).

Regarding claim 15, Beskitt discloses a similar method wherein (b) the at least one contact stripper member biasingly engages the at least one picking member (190) when no note extends therebetween (fig.15) (C13/L50-54).

Regarding claim 16, Beskitt discloses a similar method wherein (b) the at least one non-contact stripping member is disposed from the at least one picking member (fig.15).

Regarding claim 17, Beskitt discloses a similar method wherein the picking member includes an annular recess, and wherein the at least one non-contact stripper

member extends in the at least one annular recess (fig.15), and wherein in (b) a cross sectional wave configuration is imparted to the first note (fig.15) (C13/L50-60).

Regarding claim 18, Beskitt discloses a similar method prior to (a) further comprising receiving the stack of notes in a chute (28), wherein the module includes the chute (C5/L46-52) (fig.1).

Regarding claim 19, Beskitt discloses a similar method prior to receiving the stack of notes in the chute, further comprising opening a gate bounding the chute wherein opening the gate enables the chute to receive the stack of notes (C5/L46-52) (fig.1).

Regarding claim 20, Beskitt discloses a similar method and prior to (a) further comprising receiving at least one input from a user through at least one input device of an automated banking machine, wherein the at least one input is operative to identify at least one of the user and an account (C5/L1-6), receiving the stack of notes into the machine from the user, and wherein in (a) the first note is moved from the stack within the machine (C5/L45-63, C6/L20-31).

Regarding claim 21, Beskitt discloses a similar method and subsequent to (g), further comprising crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (e) (C4/L66-67, C5/L

Regarding claim 23, Beskitt discloses a similar method further comprising subsequent to (d), moving the first note in the first direction separately from another note (C14/L22-41).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beskitt USP 6,302,393 in view of Peters USP 5,267,826.

Regarding claim 11 and 12, Beskitt discloses all the limitations of the claim, but does not expressly disclose the method further comprising (h) dispensing notes from the automated banking machine, wherein the dispensing notes are removed from the at least one storage location but does not expressly disclose the storage location within a chest portion

Peters teaches the storage location (102) within a chest portion (188) of an automated banking machine (fig.5) for the purpose of preventing unauthorized access to the at least one storage location.

At the time of invention it would have been obvious to one having ordinary skill in the art to locate at least one first storage location within a chest portion of an automated banking machine, as taught by Peters, in the method of Beskitt, for the purpose of preventing unauthorized access to the at least one storage location.

Regarding claim 13, Beskitt discloses a similar method wherein the notes dispensed in (h) include notes previously determined as having the at least one characteristic of validity in (e) (C6/L21-53).

14. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beskitt USP 6,302,393 in view of Graef USP 6,783,061.

Regarding claim 21, Beskitt discloses all the limitations of the claim, but does not expressly disclose the method and subsequent to (g), further comprising crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (e) or storing data in at least one data store correlating the user with notes not determined as having the at least one characteristic of validity in (e).

Graef teaches a method of crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in (C1/L31-50) for the purpose of associating a valid deposit with the respective account holder.

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method of crediting at least one of the user and the account a value associated with notes determined as having the at least one characteristic of validity in, as taught by Graef, in the method of Beskitt, for the purpose of associating a valid deposit with the respective account holder.

Regarding claim 22, Graef teaches a method of storing data in at least one data store correlating the user with notes not determined as having the at least one characteristic of validity in (e) (C15/L45-65) for the purpose of gathering evidence of attempted theft.

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method of storing data in at least one data store correlating the user with notes not determined as having the at least one characteristic of validity, as taught by Graef, in the method of Beskitt, for the purpose of gathering evidence of attempted theft.

15. Claims 24 and 25, as best understood by the examiner (see ¶7), are rejected under 35 U.S.C. 103(a) as being unpatentable over Force USP 6,109,522 in view of Swartzendruber USP 4,159,782.

Force discloses a similar method comprising:

- a) moving a first note (188) bounding a stack of notes (146) input to the machine by a user in a first direction by engagement with at least one picking member (78) (fig.14) (C1/L10-15)
- b) engaging the first note and at least one other note in the stack with at least one stripper member (176,178) as the first note moves in the first direction (fig.14), wherein generally only the first note moves in the first direction past the at least one stripper member (C14/L40-44)
- c) sensing with at least one sensor (80) notes moved past the at least one stripper

member in the first direction (fig.14)

Force does not expressly disclose a method wherein responsive to sensing more than one note moved in the first direction past the at least one stripper member with the at least one sensor, moving at least one note relative to the first note in a second direction opposed of the first direction.

Swartzendruber teaches a method step wherein responsive to sensing more than one note moved in the first direction past the at least one stripper member with the at least one sensor, moving at least one note relative to the first note in a second direction opposed of the first direction for the purpose of transporting one note at a time (C4/L12-24).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method step of sensing more than one note moved in the first direction past the at least one stripper member with the at least one sensor, moving at least one note relative to the first note in a second direction opposed of the first direction, as taught by Swartzendruber, in the method of Force, for the purpose of transporting one note at a time.

Regarding claim 25, Force discloses a similar method wherein (d) includes moving the first note and at least one note other than the first note in a second direction (C16/L35-53), wherein the at least one note other than the first note is moved in the second direction a distance greater than the first note is moved in the second direction (fig.15,16) (note: It is clear from the figures that the stack of notes leans towards the

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wall (170,172), so as the notes finally separate, the note other than the first note will be farther from the wall and thus have moved a greater distance than the first note).

16. Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Force USP 6,109,522 in view of Abe USP 4,993,587.

Regarding claim 26, Force discloses a similar method comprising moving at least two notes in a first direction from a stack input by a user to an automated banking machine past at least one stripper member (fig.4,14) (C1/L10-13, C16/L35-36). Force does not expressly disclose the method wherein responsive to (a), moving an overlying note of the at least two notes in engagement with the at least one stripper member in a second direction opposed of the first direction such that the overlying note is moved in the second direction relative to a picked note of the at least two notes, wherein the picked note is not engaged with the at least one stripper member.

Abe teaches the method step of moving an overlying note of the at least two notes in engagement with the at least one stripper member in a second direction opposed of the first direction such that the overlying note is moved in the second direction relative to a picked note of the at least two notes, wherein the picked note is not engaged with the at least one stripper member for the purpose of feeding notes one at a time (C3/L34-63).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method of moving an overlying note of the at least two notes in engagement with the at least one stripper member in a second direction opposed of the

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first direction such that the overlying note is moved in the second direction relative to a picked note of the at least two notes, wherein the picked note is not engaged with the at least one stripper member, as taught by Abe, in the method of Force, for the purpose of feeding notes one at a time.

Regarding claim 27, Force discloses all the limitations of the claim, but does not expressly disclose the method step of moving the picked note in the first direction such that the picked note is separated from the overlying note by the at least one stripper member.

Abe teaches the method step of moving the picked note in the first direction such that the picked note is separated from the overlying note by the at least one stripper member (8) for the purpose of feeding notes one at a time (C3/L34-63).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ the method step of moving the picked note in the first direction such that the picked note is separated from the overlying note by the at least one stripper member, as taught by Abe, in the method of Force, for the purpose of feeding notes one at a time.

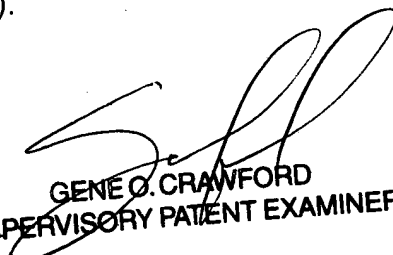
**Conclusion**

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Nicholson III whose telephone number is 571-272-5487. The examiner can normally be reached on M-F, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 571-272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GENE O. CRAWFORD  
SUPERVISORY PATENT EXAMINER

L.N.  
10/17/2005